



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,631	03/22/2004	Richard D. Wasmund JR.	092556.00001	1461

7590 11/03/2006

Holland & Knight LLP
30th Floor
131 S. Dearborn
Chicago, IL 60603

EXAMINER

WEINSTEIN, STEVEN L

ART UNIT	PAPER NUMBER
----------	--------------

1761

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,631

Applicant(s)

WASMUND, RICHARD D.

Examiner

Steven L. Weinstein

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/22/04</u> . | 6) <input type="checkbox"/> Other: ____. |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18,21,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii (JP 11-276151) and Kleinbrennerei (1997, 49,10,231-233), further in view of Duggins (4,173,656), Yocum (2,064,330), Barbier et al (EP 634108), applicant's admission of the prior art, Tagaki (JP 55-88692), Bodorev et al (RU2213137), Pennington (WO 97/42303), Sanishi (JP2002-65239), Nickol (2,807,547), Pritchett (1,976,091), McCabe (3,386,832), Analytica Chimica Acta (458,1,p55-62, 4/29/02), and Journal of Wine Research (2001, 12, 3, 175-182).

In regard to claim 1, Fujii discloses it was conventional to improve the flavor of aliquid by immersing fruitwood (e.g., cherry) in the liquid. Kleinbrennerei is relied on as further evidence of adding fruitwood to liquids to age/mature/enhance flavor of the liquid. Duggins, Yocum, Barbier et al, applicant' admission of the prior art, Tagaki, Bodorev et al, Pennington, Saneishi, Nickol, Pritchett, McCabe, Analytica Chimica Acta, and J. of Wine research, are relied on as further evidence that it was notoriously conventional in the art to expose liquids to various types of wood to enhance the liquid. Note for example that Barbier et al discloses many woods contain flavor agents useful in beverage maturation. Claim 1 also recites that the liquid is agitated. Fujii is silent in this regard. Note that the claim does not recite whether the agitation occurs before or after the step of immersing the wood. In any case, to expedite prosecution, it is, of

Art Unit: 1761

course, a notoriously old expedient to employ agitation when one desires efficient contact between two substances. In any case, as evidenced by Duggins and Yocum, it was well established in the art to agitate a liquid having flavor enhancing wood therein. Finally claim 1 recites that the wood is present in the form of "slabs". It is noted that, as disclosed, the wood is in the form of "chips" (e.g. page 6, para.3). Fujii is silent in this regard. However, once it was known that liquids exposed to wood can have their flavor enhanced, the particular shape or size of the piece or pieces of wood would have been an obvious result effective variable, derivable through routine determinations. In any case, Barbier et al, who discloses wood chips of various sizes (as well as kinds of wood) have been employed in the prior art and, in fact discloses wood pieces within the recited range of both thickness (e.g. claim 2) and surface area (e.g. claim 12). See in this regard, page 4, para. 1 of Barbier et al. Note that the further reduction in size in Barbier et al is only a preference. It is not disclosed that the wood must further be reduced. See also Bodorev et al, who also teaches wood chip dimensions in the recited range. In regard to claim 4, which recites that the slabs are toasted, Fujii appears to be silent in this regard. However, the art taken as a whole, including applicant's admission of the prior art, Duggins, Yocum, Barbier et al, McCabe, etc., disclose it was notoriously conventional to toast (also known as char) the wood that is to be used in enhancing the flavor of liquids. The art taken as a whole discloses that charred wood generally imparts a more preferred effect than wood that has not been charred. To therefore char the wood of Fujii, if indeed it is not charred, would therefore have been obvious. In regard to claims 5 and 6, which recite a range and a specific amount of alcohol, respectively,

Art Unit: 1761

since the art taken as a whole, including Fujii and applicant's admission of the prior art teach employing wood to enhance alcoholic beverages, the particular conventional alcohol content of the beverage is seen to have been an obvious function of the particular conventional alcoholic beverage one selects to enhance. Applicant is not the inventor of the alcoholic beverages. In regard to claims 7-11, which recite various degrees of charring, the art taken as a whole discloses differing degrees of charring is conventional in the art. For example, Duggins discloses that complete charring is conventional, but is not as favored as partial charring, which chars the surfaces but leaves an interior (or central portion) uncharred. In fact, Duggins discloses that employing both charred and partially charred wood has beneficial results. (e.g. col.2,para.3). Yocum also discloses surface charring to a certain depth. In regard to claims 15-17, which recite that the wood is a mixture of two are more "generation" woods (i.e. wood that has not been exposed to liquid and wood that has been exposed to liquid at least once), Fujii is silent in this regard. However, since Barbier discloses that two or more different types of wood can be used, that the different types of wood can be employed together as a mixture or sequentially, that the same type of wood can be employed sequentially and that the wood can be reused a number of times, to employ a mixture of "new" wood and wood that has been used one or more times is seen to have been an obvious matter of choice in view of the art taken as a whole. The art teaches the obvious fact that "new" wood, of course, has the most potential for liquid enhancement and that this decreases with each use, but is still usable until the wood is completely exhausted of this ability. In regard to claim 18, it would have been obvious to

Art Unit: 1761

modify Fujii, who discloses immersing wood into liquid for flavor improvement, and employ wood that is "slab" shaped and has been charred, and employ agitation of the liquid for the reasons fully detailed above. Claim 21 recites a flavored liquid, which includes flavor from apple wood. Since the art taken as a whole discloses it was known to employ a fruitwood (as well as many other woods) to flavor liquids, the particular fruitwood selected is seen to have been an obvious matter of choice to provide a flavored liquid. In regard to claims 24 and 25, to provide a liquid with the recited alcohol content would have been obvious for the reasons given in claims 5 and 6 above.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19,20,22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii or Kleinbrennei.

In regard to claims 19 and 20, since Fujii and Kleinbrennei expose liquid to fruitwood (including cherry), the fruitwood imparted,flavored liquid of Fujii and Kleinbrennei are seen to inherently anticipate claims 19 and 20. In regard to claims 22 and 23, which recite alcoholic content ranges, since Fujii and Kleinbrennei disclose whisky as the liquid to be flavored, the products of Fujii and Kleinbrennei are seen to anticipate claims 22 and 23 as well.

The remainder of the references cited on the PTO892 form are cited as art of interest.

Art Unit: 1761

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven L. Weinstein whose telephone number is 571-272-1410. The examiner can normally be reached on Monday-Friday 7:00 A.M.-2:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steve Weinstein
STEVE WEINSTEIN 1761
PRIMARY EXAMINER
12/30/06